

## **REMARKS**

The Office Action dated August 8, 2007, has been received and carefully noted. The above amendments to the specification and claims, and the following remarks, are submitted as a full and complete response thereto.

The specification has been amended. Claims 1-10, 12-23, and 25-30 have been amended to more particularly point out and distinctly claim the subject matter of the invention. Claim 31 has been added. No new matter has been added. Claims 1-31 are respectfully submitted for considerations.

The specification is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. In response to this objection, the specification has been amended to remove the embedded hyperlink as shown on page 2. As such, it is respectfully requested that the objection to the specification be withdrawn.

Claims 1-2, 13, 18, 23 and 28 were rejected on the grounds of non-statutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-6, 10, 12-13 and 17 of Application No. 10/529,577 (hereinafter, "the '577 application"). The Office Action asserted that although the claims are not identical, the claims in the present application are not patentably distinct from claims 1-2, 5-6, 10, 12-13 and 17 of the '577 application. It is respectfully requested that this provisional rejection be held in abeyance until either the present application or co-pending application are allowed.

Claim 17 was objected to because of informalities. More specifically, the Office Action asserted that claim 17 recites "different for at least two users at least one group,"

and it should read “at least two users in at least one group.” In response, claim 17 has been amended to recite “at least two users in at least one group.”

Claim 26 was objected to because it improperly depended from an earlier claim. The Office Action took the position that claim 26 lacks the antecedent support because claim 26 does not recite what is received from said requester. In response, claim 26 has been amended to recite “wherein when said storage unit receives a request from said requester, said storage unit is configured to insert the elements of presence information into a request sent to said user or an entity associated with said user.” Withdrawal of the objection is respectfully requested.

Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More specifically, the Office Action asserted that claims 1, 27, and 30 recite “what parts of said presence information” the pronoun “what” raises a question that implies which thing or which particular one of many things. In response, claims 1, 27, and 30 has been amended to recite “which elements of said presence information are to be provided to said at least one user.” As such, it is respectfully requested that the objection to claims 1, 27, and 30 be withdrawn. Claims 2-26 and 28-29 are dependent upon claims 1 and 27. Accordingly, claims 2-26 and 28-29 should be allowed at least for their dependencies upon claims 1 and 27.

Claims 1-17 and 21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Publication No. 2002/0083127 to Agrawal (Agrawal). This rejection is respectfully traversed.

Independent claim 1, upon which claims 2-26 are dependent, recites a communication system that includes a presence information unit configured to provide presence information associated with a plurality of users said presence information comprising a plurality of elements. The system includes a storing unit configured to store information defining at least one group, said group containing a plurality of users. The system also includes an information providing unit configured to provide information defining for said at least one user of said group which elements of said presence information to be provided to said at least one user.

Independent claim 27, upon which claims 28-29 are dependent, recites a method that includes defining at least one group, said group containing a plurality of users with which presence information is associated, said presence information comprising a plurality of elements. The method includes defining for said at least one user of said group which elements of said presence information are to be provided.

Independent claim 30 recites a communication system that includes presence information providing means for providing presence information associated with a plurality of users, said presence information comprising a plurality of elements. The system also includes storing means for storing information defining at least one group, said group containing a plurality of users. The system further includes information

providing means for providing information defining for said at least one user of said group elements of said presence information to be provided.

Independent claim 31 recites a system that includes presence information providing means for providing a plurality of users with which presence information is associated, said presence information comprising a plurality of elements. The system also includes storing means for storing information defining at least one group, said group containing a plurality of users. The system further includes information providing means for providing information defining for said at least one user of said group elements of said presence information to be provided.

As will be discussed below, it is respectfully submitted that Agrawal fails to disclose or suggest all of the features of any of the presently pending claims.

Agrawal generally describes a method for determining and maintaining user presence information includes capturing user presence data with an application presence server. The application presence server can be configured to update user presence data as a user initiates or exits an application. Applications associated with user presence data are configured to query an application proxy client concerning user presence data of a selected user and, based on a returned user status, deliver, discard, or redirect a message intended for the user. User presence data is stored in a user presence repository and can be provided via Internet-based or other connections to applications executed on external networks. See abstract of Agrawal.

Certain embodiments of the present application relate to improving the efficiency of the use of network bandwidth for the provision of user presence data to a requester. Presence service data may provide more than just information such as whether a particular user is available. It may contain visual, animated or sound elements, or may be application specific such as relating to a particular game. This plurality of elements of presence information may therefore represent a significant amount of data to be transmitted on the network in response to a request for presence information. This amount of data involved is multiplied when a user requests user presence information for a number of users contained in a group (or buddy) list.

In many cases, it may be that the requester does not require all of the elements of the presence information, and for instance may only be interested in the element relating to availability, for example. However, in Agrawal's system, all of the presence information would be transmitted across the network in response to a request, leading to inefficient use of network resources. By "providing information defining for said at least one user of said group which elements of said presence information are to be provided to said at least one user," as recited in claim 1, only those elements of the presence information that are required will be provided reducing the load on the network due to the transmission of unnecessary elements of the presence information.

There is no teaching or suggestion in Agrawal that only certain defined elements of the presence information should be provided to a requester. The Office Action,

however, has asserted that Agrawal discloses defining which elements of the plurality of elements of presence information are to be provided in paragraph [0041] of Agrawal.

Paragraph [0041] of Agrawal describes that user presence data can be used in various applications. For example, a buddy list can be presented to an instant messaging user to identify members of the buddy list that are currently available. Alternatively, user presence data can be configured to indicate when a user will become available, or if a user is reachable, but not currently available. User presence data can be configured to provide alerts as users log on or off an application such as an instant messaging application, or designate an address for message delivery. For example, user presence could indicate that a user is available by cell phone and currently unavailable by desktop. In addition, user presence data can include cell phone status such as data or voice mode indications and applications configured to transmit messages appropriately. See paragraph [0041], of Agrawal.

As discussed above, however, this paragraph describes only that the state, or information content, of individual elements of the user presence information (e.g. availability) can be defined. Indeed, this cited portion merely describes a number of uses to which an application may apply the presence data, depending on what information is provided in the present information, once it has been received. Thus, Agrawal fails to disclose or suggest, at least, “an information providing unit configured to provide information defining for said at least one user of said group which elements of said

presence information to be provided to said at least one user,” as recited in the presently pending claims.

Furthermore, Agrawal explicitly requires in paragraph [0039] that all applications that use the user presence data would be configured to do in a **standard manner**. This suggests that the user presence data supplied in response to a request in the system would be expected to have the same, standard, format, and content. (Emphasis Added).

Therefore, Agrawal fails to disclose or suggest all of the elements of claims 1, 27, and 30. Accordingly, it is respectfully requested that the rejection of claims 1, 27, and 30 be withdrawn.

Claim 31 also recites similar features as those recited in claim 1. Applicants incorporate herein the arguments presented above supporting the patentability of independent claim 1 to support the patentability of independent claim 31 in view of Agrawal.

Claims 18-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Agrawal, in view of U.S. Publication No. 2007/0124472 to Requena (Requena). This rejection is respectfully traversed for the following reason.

35 U.S.C. 103© states that “subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. (2) For

purposes of this subsection, subject matter developed by another person and a claimed invention shall be deemed to have been owned by the same person or subject to an obligation of assignment to the same person if (A) the claimed invention was made by or on behalf of parties to a joint research agreement that was in effect on or before the date the claimed invention was made; (B) the claimed invention was made as a result of activities undertaken within the scope of the joint research agreement; and (C) the application for patent for the claimed invention discloses or is amended to disclose the names of the parties to the joint research agreement.”

Because Requena is a patent application that was published later than the present application was filed, and because Requena is a Nokia patent application (i.e. was under a mutual obligation of assignment to Nokia Corp. as was the present application), Requena is not proper prior art to show obviousness of the claims of the present application. Requena is barred from such use by 35 U.S.C. 103©. As such, it is respectfully requested that the rejection of claims 18-20 be withdrawn.


For at least the reasons discussed above, it is respectfully submitted that the cited prior art fails to disclose or suggest all of the elements of the claimed invention. These distinctions are more than sufficient to render the claimed invention unanticipated and unobvious. It is therefore respectfully requested that all of claims 1-31 be allowed, and this application passed to issue.



If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: Petition for Extension of Time – 1 Month  
Additional Claim Fee Transmittal  
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